

REMARKS

The invention is directed to a process for manufacturing frozen aerated products wherein two open mold cavities are filled with a frozen aerated product having an overrun of between 30 and 130% and wherein the process continues by then allowing each product to expand outside its open cavity and then by moving the two open mold cavities opposite one another so that the expanded frozen aerated product in each cavity is pressed against the expanded frozen aerated product in the other cavity.

The Office's position appears to be that the Ezaki reference, although not explicitly teaching that a confection should be allowed to expand, inherently discloses such. Applicants wish to emphasize that the Office points to no explicit teaching by Ezaki of allowing the confection to expand. Moreover, applicants enclose a Declaration by one of the inventors, Paul Cheney, which indicates that one of ordinary skill would generally choose to place the filler in intimate contact with the roller, from filling through to product fusion, as Ezaki has done. Indeed, inventor Cheney indicates that in Ezaki the filler is in intimate contact with the outer surface of the rollers, preventing expansion between filling and fusion. Thus, it is not at all apparent that one of ordinary skill would choose to permit the frozen confection to expand instead of subjecting it to pressure which would prevent the expansion.

To the extent that the Office relies on inherency of the expansion step in Ezaki et al., it should be kept in mind that the present rejection is a § 103 rejection. As stated in §2141.02 of the MPEP, "obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." Moreover, the fact that a certain result or characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 IV. To establish inherency the intrinsic evidence must make clear that

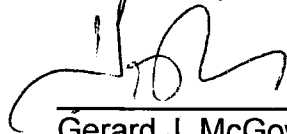
the missing descriptive matter is necessarily present in the thing described in the reference. Inherency may not be established by probabilities or possibilities.

MPEP §2112 indicates that once a reference teaching a product appears to be substantially identical and the Examiner presents evidence or reasoning intending to show inherency, the burden shifts to the applicant to show an unobvious difference. In the present case, the Office has not shown that Ezaki is substantially identical to the invention, particularly given Ezaki's closed arrangement following the filler. In contrast, applicants permit the frozen confection to expand, as reflected in the claims and as can be seen in the figures wherein the area following the filler is quite open and clearly accommodates expansion of the frozen confection. This, coupled with the Cheney Declaration, establishes that Ezaki does not inherently or necessarily permit the frozen confection to expand. Indeed, Ezaki's example concerns ice candy.

New claims 18 and 19 are presented, as supported on page 1.

In view of the foregoing, it is respectfully requested that the application be allowed.

Respectfully submitted,



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